

REMARKS

Claims 18-19, 21-22, 24, 26-28, 31-35, 41-46, 48, and 50-52 are pending. Claim 35 has been amended without disclaimer or prejudice to better comply with U.S. practice; support can be found *inter alia* in the original claims. No new matter has been added.

Applicants enclose herewith a Request for Continued Examination requesting consideration of the following remarks and entry of the references on the attached Information Disclosure Statement, which were cited in the European opposition proceeding for the European counterpart application and in co-pending U.S. Application Serial No. 10/280,324. The present amendments and following remarks address the rejections in the Final Office Action dated May 6, 2008.

Rejections under 35 U.S.C. § 112, second paragraph

Claims 18-19, 21-22, 24, 26-28, 31-35, 41-46, 48, and 50-52 remain rejected under 35 U.S.C. 112, second paragraph, for allegedly being indefinite for the recitation of “increased pelleting stability.”

The Examiner interprets the term as allegedly referring to the structural stability of the pellet. The Examiner concludes that because the specification allegedly does not provide a clear definition of the intended meaning for the term, one cannot reasonably determine the entire scope of the claims and accordingly has not given patentable weight to the term. Applicants strongly disagree and respectfully request reconsideration in view of the remarks already of record and additionally in view of the following remarks.

As stated in § 2173.02 of the M.P.E.P. “[t]he test for definiteness under 35 U.S.C. 112, second paragraph, is whether ‘those skilled in the art would understand what is claimed when the claim is read in light of the specification.’” (M.P.E.P. § 2173.02, emphasis added). If one skilled in the art is able to ascertain the meaning of the terms in light of the specification, 35 U.S.C. 112, second paragraph, is satisfied. See M.P.E.P. § 2173.02. Furthermore, the specification should also be relied on for more than just explicit lexicography or clear disavowal of claim scope to determine the meaning of a claim term when applicant acts as his or her own lexicographer; the meaning of a particular claim term may be defined by implication, that is, according to the usage of the term in context in the specification. It is entirely proper to use a

specification to interpret what the patentee meant by a word or phrase in the claim. See *Phillips v. AWH Corp.*, 415 F.3d 1303, 1321 (Fed. Cir. 2005) (en banc); and *Vitronics Corp. v. Conceptoronic Inc.*, 90 F.3d 1576, 1583 (Fed. Cir. 1996). “[I]t is legal error to construe a claim by considering it in isolation. A claim must be read in view of the specification of which it is a part.” *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 621 (Fed. Cir. 1995).

It is thus entirely proper to use a specification to interpret what the patentee meant by a word or phrase in the claim. Contrary to the Examiner’s basis for concluding indefiniteness that the specification allegedly does not provide a clear definition, the meaning of a particular claim term may be defined by implication, that is, according to the usage of the term in context in the specification. See *Phillips v. AWH Corp.*, 415 F.3d 1303, 1321 (Fed. Cir. 2005) (en banc); and *Vitronics Corp. v. Conceptoronic Inc.*, 90 F.3d 1576, 1583 (Fed. Cir. 1996). Contrary to the Examiner’s assertion, the specification can be used to interpret a claim term without an explicit definition. The term “pelletting stability” recited in the claims is defined in the present specification by implication according to the usage of the term in the specification (see for example, specification at page 18 line 12 through page 19 line 30, Example 5). See *Phillips*, 415 F.3d at 1321. In Example 5, the term “pelletting stability” is used throughout, for example, at page 18, line 16, “. . . and the pelletting stability of these samples were tested,” at page 17, line 15 “Comparison of pelletting stabilities.” Additionally in Example 10 at page 22, the results of the pelletting test indicate that “even with similar activities (B and C) the highest activity formulation (C; 6830 FTU/g, of the invention) gave a much higher pelletting stability.” Furthermore, the results of the pelletting stability testing are described in Table 2 and are summarized as follows at page 19, lines 24-25 “. . . granules with the highest enzyme concentration had much higher pelletting stability.” The results shown in Table 2 are “Enzyme yield after pelletting.” Thus the term “pelletting stability” is used in reference to the results of Table 2 which shows “Enzyme yield after pelletting.” Therefore, according to the usage of the term in context in the specification, one skilled in the art would understand the meaning of the term and what is claimed.

The Examiner also argues that when more than one reasonable interpretation exists, Applicants should provide a clear statement of how Applicants wish the term to be interpreted.

In addition to the meaning of the term defined by its usage in context in the specification, Applicants have already repeatedly provided how the term should be interpreted, for example in the Amendment in Response to Non-Final Action dated January 24, 2008. In that response, Applicants presented a declaration and multiple references clearly providing how the term should be interpreted. See also *In re Zeltz*, 893 F.2d 319, 321 (Fed. Cir. 1989) (holding that “[w]hen the applicant states the meaning that the claim terms are intended to have, the claims are examined with that meaning, in order to achieve a complete exploration of the applicant’s invention and its relation to the prior art.” The court further held that “the inquiry during examination is patentability of the invention as ‘the applicant regards’ it.”).

Thus, it is clear to one skilled in the art what the recitation of “pelletting stability” means based on the use in context of the specification and based on how the Applicant regards the invention. Accordingly, Applicants respectfully submit that the claims are clear when read in view of the specification, and therefore, satisfy the requirements under 35 USC § 112, second paragraph. Reconsideration and withdrawal of the rejection is respectfully requested.

Rejections under 35 U.S.C. § 103

Claims 18-19, 21, 24, 26-28, 31-35, 41-45, 48, 50-52 remain rejected under 35 U.S.C. 103(a) for obviousness over Nielsen *et al.* (hereinafter “Nielsen”) in view of Ghani. Claims 22 and 46 remain rejected under 35 U.S.C. 103(a) for obviousness over Nielsen in view of Ghani and further in view of Markussen *et al.* Claims 18-19, 21-22, 24, 26-28, 31-35, 41-46, 48, 50-52 remain rejected under 35 U.S.C. 103(a) for obviousness over Nielsen in view of Ghani and further in view of Haarasilta.

The Examiner appears to base the obviousness rejections on not giving patentable weight to the term “increased pelletting stability” recited in the claim preamble. Applicants strongly disagree with the Examiner’s interpretation for the reasons already of record and additionally for the following reasons.

“[A] claim preamble has the import that the claim as a whole suggests for it.” *Bell Communications Research, Inc. v. Vialink Communications Corp.*, 55 F.3d 615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995). “If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is ‘necessary to give life,

meaning, and vitality’ to the claim, then the claim preamble should be construed as if in the balance of the claim.” *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999). *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951) (A preamble reciting “An abrasive article” was deemed essential to point out the invention defined by claims to an article comprising abrasive grains and a hardened binder and the process of making it. The court stated “it is only by that phrase that it can be known that the subject matter defined by the claims is comprised as an abrasive article. Every union of substances capable *inter alia* of use as abrasive grains and a binder is not an ‘abrasive article.’” Therefore, the preamble served to further define the structure of the article produced.). In *Poly-America LP v. GSE Lining Tech. Inc.*, 383 F.3d 1303, 1310, 72 USPQ2d 1685, 1689 (Fed. Cir. 2004), the court stated that “a [r]eview of the entirety of the ‘047 patent reveals that the preamble language relating to ‘blown-film’ does not state a purpose or an intended use of the invention, but rather discloses a fundamental characteristic of the claimed invention that is properly construed as a limitation of the claim...” Additionally, clear reliance on the preamble during prosecution to distinguish the claimed invention from the prior art transforms the preamble into a claim limitation because such reliance indicates use of the preamble to define, in part, the claimed invention. See also MPEP § 2111.02.

Applicants submit that the term “increased pelleting stability” should be given patentable weight since the term gives “life, meaning, and vitality” to the claim, the term has been used to further define the claimed invention, and since Applicants have repeatedly relied on the term throughout prosecution to distinguish the references cited by the Examiner. Furthermore, the Examiner has admitted that the “property/characteristic [is] required in the claimed product.” (see Office Action dated May 6, 2008, page 5, item 13, last sentence). Given the Examiner’s own statement that the property is required, the term should be given patentable weight for this additional reason.

Moreover, the examiner bears the initial burden of establishing *prima facie* obviousness. See *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). To support a *prima facie* conclusion of obviousness, the prior art must disclose or suggest all the limitations of the claimed invention. *In re Lowry*, 32 F.3d 1579, 1582, 32 USPQ2d 1031, 1034 (Fed. Cir. 1994); see also *Ex parte Alexander*, 86 USPQ2d 1120, 1122 (BPAI 2007) (where the Board

reversed the obviousness rejection in part because the Examiner had not identified all the elements of the claim).

The Examiner refers to Nielsen as disclosing a granulate of at least 6000 FTU/gram. Although Nielsen refers to several enzyme concentrations throughout the specification, the disclosure of the alleged granulate of at least 6000 FTU/gram is found in Example 3 at page 16-17 of Nielsen. The experiment described in Example 3 of Nielsen comparing the effect of an animal diet with and without phytase discloses the composition of the diet, the diet being pelleted, then one group of pigs being fed the diet and the second group of pigs being fed “the same diet but with addition of phytase 20.3 g/100 kg feed of Phytase Novo™ (an *Aspergillus* phytase, 7370 FYT/g).” (emphasis added; see Nielsen, Example 3, page 16-17). Thus, Nielsen suggests that for their animal diet with phytase, the phytase was applied to an already pelleted diet. In contrast, for the present phytase-containing granulate to have increased pelleting stability as claimed, the phytase additive is added prior to pelleting. Therefore, Nielsen does not disclose a high activity phytase-containing granulate having increased pelleting stability as claimed. Since the Examiner relies on Nielsen for the alleged teaching of a granulate of at least 6000 FTU/gram, Ghani, Markussen, or Haarasilta do not remedy the lack of teaching of Nielsen. Since Nielsen does not teach a granulate of at least 6000 FTU/gram as claimed, Nielson, Ghani, Markussen, or Haarasilta, alone or in combination, do not disclose or teach all the claim limitations and as such a *prima facie* case of obviousness has not been established.

Moreover, the Examiner has acknowledged that neither Nielson, Ghani, Markussen, nor Haarasilta discuss pelleting stability and that Nielsen additionally does not teach extrusion (see Office Action dated July 27, 2007, page 6, item 14). By the Examiner’s own statement, Nielson, Ghani, Markussen, and Haarasilta, alone or in combination, do not disclose or teach all the claim limitations and as such a *prima facie* case of obviousness has not been established.

The Examiner further alleges that any phytase granulate wherein the phytase activity is at least 6000 FTU/gram would have the recited “increased pelleting stability.” As found by the court in *In re Antonie*, which reversed the Board’s finding of obviousness, it is the invention as a whole, and not some part of it, which must be obvious under 35 U.S.C.S. § 103. *In re Antonie*, 559 F.2d 618, 619-620 (CCPA 1977); see also MPEP § 2141.02 V. The claim does not recite any phytase granulate as alleged by the Examiner. The invention as a whole must be evaluated,

i.e. the particular granulate claimed and disclosed in the specification. For this additional reason, a *prima facie* case of obviousness has not been established.

In response to Applicants' previous "inherency" argument, the Examiner further asserts that "[i]t is reiterated herein that the "inherency" argument made is in reference to a property/characteristic required in the claimed product . . ." (see Office Action dated May 6, 2008, page 5, item 13, last sentence). It is well established that inherency of missing features/limitations is limited to the context of anticipation under 35 U.S.C. § 102. In other words, obviousness under 35 U.S.C. § 103(a) cannot be established through inherency. Furthermore, inherency may not be established by probabilities or possibilities and "[t]he mere fact that a certain thing *may* result from a given set of circumstances is not sufficient [to establish inherency]." See *In re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993). "That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown," even if the inherency of a certain feature is later established. *Id.* Furthermore, the court in *In re Antonie* found that the prior art did not reveal the property which appellant discovered and, therefore, there was no basis to find obviousness. *In re Antonie*, 559 F.2d 618, 619-620 (CCPA 1977) (The claimed wastewater treatment device had a tank volume to contractor area of 0.12 gal./sq. ft. The court found the invention as a whole was the ratio of 0.12 and its inherent property that the claimed devices maximized treatment capacity regardless of other variables in the devices. The prior art did not recognize that treatment capacity was a function of the tank volume to contractor ratio, and therefore the parameter optimized was not recognized in the art to be a result-effective variable.); see also *In re Shetty*, 566 F.2d 81, 86 (CCPA 1977) and *In re Naylor*, 369 F.2d 765, 768 (CCPA 1966); see also MPEP § 2141.02 V. Because none of the references cited by the Examiner discuss pelleting stability as also acknowledged by the Examiner, there is no basis for finding obviousness. Moreover, analogous to *In re Antonie*, the references cited by the Examiner did not recognize that increased pelleting stability was a function of the high activity phytase-containing granulate as claimed. For this additional reason, a *prima facie* case of obviousness has not been established.

Analogous to the holdings in *In re Antonie* and *In re Rijckaeert*, Applicants submit that Nielson, Ghani, Markussen, and Haarasilta do not render the claims obvious because Nielson, Ghani, Markussen, and Haarasilta, alone or in combination, do not teach, suggest or disclose

increased pelleting stability of the high activity phytase-containing granulate as required by the claims.

Nielson, Ghani, Markussen, and Haarasilta are not combinable for the reasons already of record in the previous responses. Assuming *arguendo* they were combinable, the combination of Nielson, Ghani, Markussen, and Haarasilta still does not arrive at the claimed invention. Since the phytase in Nielsen was applied to an already pelleted diet, the combination of Nielson, Ghani, Markussen, and Haarasilta does not teach or suggest the present phytase-containing granulate having increased pelleting stability as claimed where the phytase additive is added prior to pelleting. For this additional reason, a *prima facie* case of obviousness has not been established.

For at least these reasons, reconsideration and withdrawal of the obviousness rejections are respectfully requested for claims 18 and 19 and the claims dependent therefrom. See *In re Fine*, 837 F.2d 1071, 1076 (Fed. Cir. 1988) (holding that if an independent claim is nonobvious then any claim dependent therefrom is nonobvious).

CONCLUSION

For at least the above reasons, Applicants respectfully request withdrawal of the rejections and allowance of the claims. If any outstanding issues remain, the Examiner is invited to telephone the undersigned at the number given below.

Accompanying this response is a Request for Continued Examination (RCE) with the required fee authorization. The RCE and response is filed within the three-month period for response from the mailing of the Final Office Action to and including August 6, 2008. No further fee is believed due. However, if a fee is due, please charge our Deposit Account No. 03-2775, under Order No. 12810-00682-US from which the undersigned is authorized to draw.

Respectfully submitted,

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